

REMARKS/ARGUMENTS

Claim Rejections - 35 USC § 103

Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent App. Pub. No. 2001/0010592 (Nakamura) in view of U.S. Patent No. 5,898,518 (Biber). Applicant respectfully traverses the rejection and courteously requests reconsideration for the following reasons.

On page 3 of the Final Office Action, the Examiner states the Nakamura reference fails to describe the beam splitter arranged between the main objective and the zoom and Applicant agrees. The Examiner relies on Biber to conclude that it would have been obvious to a person of ordinary skill in the art to arrange the beam splitter of Nakamura between the main objective and zoom system for (i) the advantages taught in col. 1, lines 51-65 of Biber reference or (ii) to reduce the number of parts (multiple objectives) as would be understood by one of ordinary skill. Applicant respectfully disagrees.

Col. 1, lines 51-65 of the Biber reference describes an arrangement to allow either a main observer or a co-observer to optimize illumination characteristics by providing an illuminating unit that rotates relative to the main observer and the co-observer, so that either the main observer or the co-observer may control the illuminating unit without having to change their viewing positions. In Nakamura, the illumination system 13 is housed in main microscope body 2 and receives light from optical fiber 14. Therefore, repositioning beam splitter B1 of Nakamura to a location between objective 21 and zoom 22 would do nothing at all for achieving the purported advantage described at Col. 1, lines 51-65. The motivating advantage stated in the Office Action would not be furthered by the suggested modification.

As to reducing parts, Nakamura specifically and repeatedly teaches away from having a shared objective for the main observer and co-observer. Nakamura teaches that it is desirable to have a separate objectives for the main observer and co-observer to enable independent magnification adjustment so that different surgical procedures may be performed simultaneously by the main observer and the co-observer. See Nakamura at paragraphs [0015], [0029] and [0046]. Therefore, the prior art itself, which one skilled in the art at the time of the invention would refer to for teaching, states that it is an advantage, not a disadvantage, to have independent objectives.

Another aspect of Nakamura runs counter to modifying the location of beam splitter B1 as suggested in the Office Action. In particular, Nakamura is built for easy detachment of the assistant's microscope 7, whereby a main observer is given a wide view with the naked eye around the target (object). Paragraph [0046] states:

The assistant microscope of any one of the first and second embodiments is easy to detach when not needed, and the stereomicroscope without the assistant microscope is operable by itself to observe a target. If the assistant microscope is removed, an observer on the stereomicroscope may secure a wide view around the stereomicroscope when seeing a target with the naked eye.

This aspect is also mentioned at paragraph [0030] of Nakamura. If one were to relocate beam splitter B1 as suggested in the Office Action, easy removal of the assistant's microscope would become a much more challenging design feature because the assistant's microscope 7 would no longer be at the bottom of the main microscope body 2 (note that Biber does not even describe removal of co-observer microscope 37), and a net gain in space between the object and the main microscope body upon removal of the assistant's microscope would be forfeited.

In light of the above comments, applicant respectfully contends that the combined teachings of Nakamura and Biber would not have rendered claim 14 obvious at the time the invention was made.

The prior art references when combined must teach or suggest all the claim limitations. MPEP 706.02(j). Here, the references fail to teach or suggest the beam splitter arranged between the main objective and the zoom. It is improper to combine references where the references teach away from their combination, and the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP 2145. In this respect, by following the suggestions on page 3 of the Office Action, the assistant's microscope of Nakamura would not be easily detachable, nor would it have an independent objective system, both important features of the primary reference.

With specific regard to claim 28, discussed at page 5 of the Final Office Action, the Examiner remarks that "the combination of Nakamura and Biber suggests a first part (L2) of the main objective is used for the main observation beam paths of the main microscope, and a second part (M1) of the main objective is used for the illumination beam path, ...". Applicant

strongly disagrees with the characterization of mirror M1 as being an objective lens part. This runs contrary to well-known understanding of the term “objective,” which is a lens.

At page 6 of the Final Office Action, the Examiner has responded to some of the above arguments. The Examiner seems to argue that there is motivation to move the beam splitter and use a common objective in Nakamura, as suggested by Biber, in order to optimize illumination for both observation paths (“Nakamura fails to teach that the illumination is optimized for both observation beam paths” - Final Office Action p. 6). However, this deficiency of Nakamura would be directly solved by one skilled in the art by de-coupling illumination system 13 of Nakamura from main stereomicroscope 1 of Nakamura, which is suggested by Biber which teaches an independent illumination unit (2, 32, 42). One skilled in the art would not move the beam splitter and use a common shared objective, as this would not by itself solve the illumination problem, but would eliminate the advantages of separate objectives touted by Nakamura.

The Examiner further argues at page 6 that the prior art must be considered in its entirety. Applicant agrees. When this is done, the entire disclosures of Biber and Nakamura must be considered. As discussed above, the teachings would not have made it obvious to one skilled in the art to modify Nakamura to meet the limitations of claim 14 as the Examiner concludes.

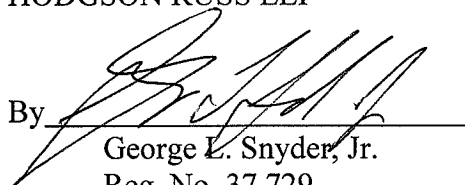
For the reasons above, favorable reconsideration of claims 14-29 is respectfully requested.

Conclusion

The present application is thought to be in a condition for allowance. If the Examiner has any questions, or the attorneys for applicant can assist in any way, the undersigned attorney may be contacted at the number provided below. The Examiner is authorized to charge any additional fees to deposit account number 08-2442.

Respectfully submitted,
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Response to Final Office Action

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